1639

DOCKET NO.: 01076

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:	:	
PAGNIEZ et al.	:	Examiner: G.L. Helmer
SERIAL NO.: 09/821,463	:	Art Unit: 1638
FILED: June 21, 2001	:	

#10
7/17/03

FOR: METHOD FOR OBTAINING TRANSGENIC PLANTS EXPRESSING A PROTEIN WITH ACTIVITY PRODUCING HYDROGEN PEROXIDE BY TRANSGENIC TRANSFORMATION BY AGROBACTERIUM RHIZOGENES

RESPONSE TO RESTRICTION REQUIREMENT

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Responsive to the requirement for restriction that was made under 35 U.S.C. §§121 and 372 on March 25, 2003, the period for response having been extended from May 25, 2003 June 25, 2003 by a Petition for Extension of Time incorporated herewith, Applicants hereby elect to prosecute, with traverse, the invention of Group I, claims 16-32, 36 and 37 as presently amended (claims 16-35 were subject to the restriction requirement), drawn to methods for transforming plants comprising the use of *Agrobacterium rhizogenes* and a gene encoding a H_2O_2-producing protein, as set forth in the restriction requirement.

This election is made with traverse for the following reasons:

The present application was filed under 35 U.S.C. § 371 as a U.S. national phase application of PCT/FR99/02412 and, as such, is subject to the unity requirements set out in

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PCT Rules 13.1-13.4 and 37 C.F.R. §1.475, as well as the PCT Administrative Instructions and Annex B. It is to be further noted that the scope of the claims presently before the U.S. Patent and Trademark Office is identical to that of the claims of the international application.

In the present application, the International Preliminary Examination Authority has already reviewed unity of invention during international preliminary examination. No finding of lack of unity was made during the international stage. It is therefore apparent that the International Preliminary Examination Authority has already determined that the criteria of PCT Rule 13 are satisfied in this application.

Furthermore, according to Article 27, paragraph 1, of the PCT, it is not permissible for a national office to require compliance with requirements that are different from or in addition to the implementing rules of the PCT and the Regulations.

In view of the foregoing, it was clearly improper for the Examiner to raise an objection of lack of unity of invention during the US national phase of the present U.S. national phase application.

Even assuming, *arguendo*, that it is proper for an objection of lack of unity to be raised in this U.S. national phase application, it is Applicants' belief that the Examiner has improperly applied the "unity of invention" criterion of PCT Rule 13.

Under PCT Rule 13, Applicants are entitled to examination of a single inventive concept (unity of invention) as determined by a technical relationship among the groups that involves at least one common or corresponding special technical feature.

Rule 13.1 stipulates that an international application shall relate to an invention or to a group of inventions so linked as to form a single general inventive concept.

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